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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,351

Applicant(s)

BANCON ET AL.

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2/10/04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 45-55 and 62-66 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 is indefinite as to the phrase "grinding wheel provided with an abrasive product" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 45 is also indefinite as to the blank (lines 3-4) because the examiner is unclear as to if the "another constituent" as defined on line 4 is part of the blank or not. If it is part of the blank, how can "the at least another constituent" be superposed with the blank, as defined on line 5. It is apparent from the specification and claim 56 that the "another constituent" is **not** part of the blank, and thus claim 45 should be rewritten to clearly define this.

Claim 47 is indefinite as to the phrase "abrasive grains provided with a coating constituted by a binder by" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 47 is also indefinite as to the entire phrase "prior to providing...binder by" because this phrase is not defined in a clear and concise manner.

Claim 48 is indefinite as to the phrase "abrasive grains provided with a coating constituted by a binder by" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 48 is also indefinite as to the entire phrase "prior to providing...binder by" because this phrase is not defined in a clear and concise manner.

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Claim 51 is indefinite as to the phrase "grinding wheel provided with an abrasive product" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 51 is indefinite as to the phrase "grinding wheel provided with an abrasive product" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 62 is indefinite as to the phrase "grinding wheel provided with an abrasive product" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

Claim 65 is indefinite because it is claiming a double range for the thickness which is improper.

Claim 66 is indefinite as to the phrase "grinding wheel provided with an abrasive product" because the examiner is unclear as to what this is defining, thus rendering the scope of the claim unclear. What does this mean and how is it provided?

The other claims are indefinite because they depend on indefinite claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

PREVIOUS REJECTIONS:

Claims 62-65 are rejected under 35 U.S.C. 103(a) as obvious over either (1) Fukuda (453), (2) Huber et al. or (3) Padberg et al. for the same reasons set forth in the previous rejection of claims 40-43, which is incorporated herein by reference. The new claims are consistent with the old claims.

Claims 62-63 and 65 are rejected under 35 U.S.C. 103(a) as obvious over White et al. for the same reasons set forth in the previous rejection of claims 40-43, which is incorporated herein by reference. The new claims are consistent with the old claims.

Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (148) for the same reasons set forth in the previous rejection of claims 40-43, which is incorporated herein by reference. The new claims are consistent with the old claims.

Claims 45, 46, 49, and 62-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shoemaker for the same reasons set forth in the previous rejection of claims 23, 24, 27 and 40-41 which is incorporated herein by reference. The new claims are consistent with the old claims.

Claims 47-48, 50-61 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker for the same reasons set forth in the previous rejection of claims 25, 26, 28-39

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and 42-44 which is incorporated herein by reference. The new claims are consistent with the old claims.

NEW REJECTIONS:

Claims 45 and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either (1) Goepfert et al., (2) Melton et al., or (3) Upper.

Goepfert et al. teach in column 2, line 53-column 3, line 45, a process for making an abrasive wheel which comprises first forming an abrasive-included felted fibrous sheet (i.e. pre-formed sheet), superposing one or more additional sheet layers (i.e. encompasses claimed "another constituent") on the first sheet and subjecting the entire assembly to heat and pressure.

Melton et al. teach in the entire document, especially the claims, a process for making an abrasive wheel which comprises first forming an abrasive-included felted fibrous sheet (i.e. pre-formed sheet), superposing one or more additional sheet layers (i.e. encompasses claimed "another constituent") on the first sheet and subjecting the entire assembly to heat and pressure.

Upper teach in the entire document, especially the claims, a process for making an abrasive wheel which comprises first forming an abrasive-included felted fibrous sheet (i.e. pre-formed sheet), superposing one or more additional sheet layers (i.e. encompasses claimed "another constituent") on the first sheet and subjecting the entire assembly to heat and pressure.

The claimed invention is anticipated by the references because said references teach methods which comprise superimposing at least two layers of constituents, one being a blank, heating and pressing the layers. As can be seen from the references, the first layer is a pre-

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formed abrasive-included felted fibrous sheet, thus reading on the claimed blank because it is a self-sustaining layer.

Claims 50, 51, 53, 54, 55, 61 and 66 are rejected under 35 U.S.C. 103(a) as obvious over either (1) Goepfert et al., (2) Melton et al., or (3) Upper.

The above claims relate to an assembly line to produce the grinding wheel.

The above references teach methods which comprise superimposing at least two layers of constituents, heating and pressing the layers. As defined above, the instant claims relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a blank making station, a layer-lying station, a heating station and a pressing station is well within the level of ordinary skill in the art. In other words, all the references teach the claimed steps and the use of an assembly line to accomplish said steps in obvious to the skilled artisan. With respect to the structure of the press, the reference teach a press, in general, and it is the examiners position that this makes obvious the claimed press because **"A generic disclosure (of a press) renders a claimed species (specific structure of the press) prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** In addition, one skilled in the art would have found the claimed press structure obvious in the absence of any evidence showing the contrary. With respect to the factory, it is the examiners position that the pre-fabrication of the sheets can be viewed as the first zone in the reference and the second zone can be viewed as the assembly (layer-laying) station, thus meeting the claimed limitations.

Claim 45 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Robie et al.

Robie et al. teach in the entire document, especially the claims, a process for making an abrasive wheel which comprises first forming an abrasive-included felted fibrous sheet (i.e. pre-formed sheet), superposing one or more additional sheet layers (i.e. encompasses claimed "another constituent") on the first sheet and subjecting the entire assembly to pressure.

The claimed invention is anticipated by the reference because said reference teaches a method which comprise superimposing at least two layers of constituents, one being a blank, heating and pressing the layers. As can be seen from the reference, the first layer is a pre-formed abrasive-included felted fibrous sheet, thus reading on the claimed blank because it is a self-sustaining layer.

Claims 50 and 66 are rejected under 35 U.S.C. 103(a) as obvious over Robie et al.

The above claims relate to an assembly line to produce the grinding wheel.

The above references teach methods which comprise superimposing at least two layers of constituents and pressing the layers. As defined above, the instant claims relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a layer-lying station and an evacuation station, as defined by claim 50 is well within the level of ordinary skill in the art. In other words, all the references teach the claimed steps and the use of an assembly line to accomplish said steps is obvious to the skilled artisan. With respect to the factory, it is the examiners position that the pre-fabrication of the sheets can be

viewed as the first zone in the reference and the second zone can be viewed as the assembly (layer-laying) station, thus meeting the claimed limitations.

Claim 45 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either (1) Field, (2) Osenberg or (3) Oide.

Field teach in the entire document, a process for making an abrasive wheel which comprises first forming an abrasive disc (i.e. pre-formed disc) and superposing one or more additional discs (i.e. encompasses claimed "another constituent") on the first disc.

Osenberg teach in column 2, lines 46-59, a process for making an abrasive wheel which comprises first forming an abrasive disc (i.e. pre-formed disc) and superposing one or more additional discs (i.e. encompasses claimed "another constituent") on the first disc.

Oide teach in column 3, lines 39+, a process for making an abrasive wheel which comprises first forming an abrasive disc (i.e. pre-formed disc) and superposing one or more additional discs (i.e. encompasses claimed "another constituent") on the first disc.

The claimed invention is anticipated by the references because said references teach methods which comprise superposing at least two layers of constituents, one being a blank. As can be seen from the references, the first disc is a pre-formed abrasive disc, thus reading on the claimed blank because it is a self-sustaining layer.

Claims 50 and 66 are rejected under 35 U.S.C. 103(a) as obvious over either (1) Field, (2) Osenberg or (3) Oide.

The above claims relate to an assembly line to produce the grinding wheel.

The above references teach methods which comprise superimposing at least two layers of constituents and pressing the layers. As defined above, the instant claims relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a layer-lying station and an evacuation station, as defined by claim 50 is well within the level of ordinary skill in the art. In other words, all the references teach the claimed steps and the use of an assembly line to accomplish said steps is obvious to the skilled artisan. With respect to the factory, it is the examiners position that the pre-fabrication of the sheets can be viewed as the first zone in the reference and the second zone can be viewed as the assembly (layer-laying) station, thus meeting the claimed limitations.

Claims 46-48 are rejected under 35 U.S.C. 103(a) as obvious over either (1) Field or (2) Osenberg both in view of Padberg et al.

Padberg et al. teaches in the claims, that abrasive discs are known to be made by molding an abrasive mixture in a press mold.

Both primary references use preformed abrasive discs and it is the examiners position that one skilled in the art would have found the claimed molding method obvious in the primary references because this is a conventionally known way to make abrasive discs, as is clearly shown by the secondary reference. Although the leveling limitation is not defined, this is obvious to the skilled artisan depending on the desired thickness of the discs. In view of this, the claimed molding method is obvious to the skilled artisan. With respect to the use of a reinforcing material, this is obvious to the skilled artisan in order to optimize the strength of the discs, absent evidence to the contrary.

Claims 46-49 and 56-61 are rejected under 35 U.S.C. 103(a) as obvious over Oide.

The primary reference uses a preformed abrasive disc and it is clearly stated that the abrasive discs are made by press molding. Although the leveling limitation is not defined, this is obvious to the skilled artisan depending on the desired thickness of the discs. With respect to the use of a reinforcing material, this is obvious to the skilled artisan in order to optimize the strength of the discs, absent evidence to the contrary. Instant claims 56-61 relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a blank making station (molding station), a layer-lying station, and a pressing station is well within the level of ordinary skill in the art. In other words, the primary reference teaches the claimed steps of press molding, assembly and pressing the assembled product) and it is the examiners position that the use of an assembly line to accomplish said steps is obvious to the skilled artisan. With respect to the structure of the press, the reference teaches a press, in general, and it is the examiners position that this makes obvious the claimed press because **"A generic disclosure (of a press) renders a claimed species (specific structure of the press) prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** In addition, one skilled in the art would have found the claimed press structure obvious in the absence of any evidence showing the contrary. The examiner acknowledges that the reference heats the article after it is assembled, but since reversing the order of steps in a process does not impart patentability when no unexpected result is obtained,

see Ex parte Rubin (POBA 1959) 128 U.S.P.Q. 440, Cohn v. Comr. Pats. (DCDC 1966) 251 F Supp 378, 148 U.S.P.Q. 486, no patentable distinction is seen to exist.

Claims 45, 46 and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hurst (981).

Hurst (981) teach in column 2, line 7-column 4, line 40, a process for making an abrasive wheel which comprises first forming an abrasive disc containing a reinforcing material (i.e. pre-formed disc) and superposing one or more additional discs (i.e. encompasses claimed "another constituent") on the first disc.

The claimed invention is anticipated by the reference because said reference teaches a method which comprise superposing at least two layers of constituents, one being a blank. As can be seen from the references, the first disc is a pre-formed abrasive disc, thus reading on the claimed blank because it is a self-sustaining layer.

Claims 50 and 66 are rejected under 35 U.S.C. 103(a) as obvious over Hurst (981).

The above claims relate to an assembly line to produce the grinding wheel.

The above reference teaches a method which comprise superimposing at least two layers of constituents and pressing the layers. As defined above, the instant claims relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a layer-lying station and an evacuation station, as defined by claim 50 is well within the level of ordinary skill in the art. In other words, the reference teaches the claimed steps and the use of an assembly line to accomplish said steps in obvious to the skilled

artisan. With respect to the factory, it is the examiners position that the pre-fabrication of the sheets can be viewed as the first zone in the reference and the second zone can be viewed as the assembly (layer-laying) station, thus meeting the claimed limitations.

Claims 47-48 and 51-61 are rejected under 35 U.S.C. 103(a) as obvious over Hurst (981) in view of Padberg et al.

The primary reference use a preformed abrasive disc and it is the examiners position that one skilled in the art would have found the claimed molding method obvious in the primary references because this is a conventionally known way to make abrasive discs, as is clearly shown by the secondary reference. Although the leveling limitation is not defined, this is obvious to the skilled artisan depending on the desired thickness of the discs. In view of this, the claimed molding method is obvious to the skilled artisan. Instant claims 51-61 relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a blank making station (molding station), a layer-lying station, and a pressing station is well within the level of ordinary skill in the art. In other words, the combined references teach the claimed steps of press molding, assembly and pressing the assembled product) and it is the examiners position that the use of an assembly line to accomplish said steps is obvious to the skilled artisan. With respect to the structure of the press, the primary reference teach a press, in general, and it is the examiners position that this makes obvious the claimed press because **"A generic disclosure (of a press) renders a claimed species (specific structure of the press) prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir.**

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1983); *In re Susi* 169 USPQ 423 (CCPA 1971)". In addition, one skilled in the art would have found the claimed press structure obvious in the absence of any evidence showing the contrary.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the claims of copending Application No. 10/169,740 in view of Padberg et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice or the copending claims would render obvious the instant claims.

The copending application uses a blank and it is the examiners position that one skilled in the art would have found the claimed molding method obvious in the primary references because this is a conventionally known way to make abrasive discs (i.e. encompasses abrasive blank), as is clearly shown by the secondary reference. Although the leveling limitation is not defined, this

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is obvious to the skilled artisan depending on the desired thickness of the discs. In view of this, the claimed molding method is obvious to the skilled artisan. Instant claims 51-61 relate to an assembly line to produce the grinding wheel and it is the examiners position that the use of an assembly line having a blank making station (molding station), a layer-lying station, and a pressing station is well within the level of ordinary skill in the art. With respect to the structure of the press, the copending application claims a press, in general, and it is the examiners position that this makes obvious the claimed press because **"A generic disclosure (of a press) renders a claimed species (specific structure of the press) prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** In addition, one skilled in the art would have found the claimed press structure obvious in the absence of any evidence showing the contrary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 2/3/04 have been fully considered but they are not persuasive.

With respect to the rejection of the product claims (grinding wheel-claims 62-65), although the prior art applied ((1) Fukuda (453), (2) Huber et al., (3) Padberg et al., (4) White et al. and (5) Fukuda (148)) fails to teach the claimed method of making the grinding wheel (rejections have been dropped), applicants have not provided any evidence that the claimed grinding wheel is different from the prior art grinding wheels. As is well established, the use of

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process limitations to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964.

With respect to the rejection based on Shoemaker, applicants argue that the claimed method is not disclosed by this reference because the layer (6) disclosed by this reference is a non-usable layer. The examiner is aware of what layer (6) of the reference is but fails to see how this is different from the claimed blank. The layer of the reference is made from an abrasive material and is molded to form a self sustaining layer, thus reading on a blank and thus claim 45. The disclosure of this layer being non-useful is immaterial to the instant claims because **the instant claims do not define that the blank provides the grinding function and therefore the claimed blank reads on the non-useful abrasive layer of the reference.** Finally, assuming further arguendo, the grinding function of the instant claims can be accomplished from the "other constituent" that is superposed on the blank, and not the blank itself. It appears that applicants also argue that the reference does not teach the method of making the blank. Contrary to applicants position, the reference clearly teaches that an abrasive mixture which forms the first layer (6) is molded and this reads on the claimed blank making method (claims 47-48). With respect to the other claims, the examiner made an obviousness rejection based on these claims which has not been addressed. The mere statement that the prior art does not suggest these features is not sufficient, especially since obvious reasoning has been provided in the rejection. Since said obvious reasoning not being addressed in applicants response, no further comment is necessary. In other words, applicants have not argued why the skilled artisan would not find the use of an assembly line obvious.

To comment on Goepfert (U.S. Patent No. 2,540,112), as defined on page 8 of the response, although the reference might not use the pressure of the present invention, the instant claims do not define this.

This action is not made final because additional rejections have been applied.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

Applicants use process limitations to define the product and "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964.

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Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

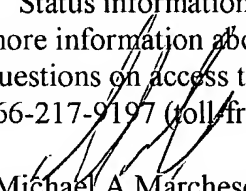
In re Linder 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM
4/04


Michael A Marcheschi
Primary Examiner
Art Unit 1755